REMARKS

All claims that are pending in the application that is 1, 3 - 6, 8, 12, 14, 15 and 27 have been rejected under 35 U.S.C. 102 as being anticipated by Babler, U.S. 5,997,627.

Before discussing how the present claims distinguish over Babler, a brief explanation of the invention may be helpful. With reference to Figure 1 in the application, a copy of which is attached to this Response, the invention includes a coating 2 applied to a substrate 4. The coating includes a layer 6 containing fluorescent colorants 8 dispersed in a resinous binder and a layer 10 containing light absorbing particles 12 dispersed in a resinous binder.

When incident visible (white) light a depicted by I in Figure 1 strikes the colorants 8 a portion of the light is absorbed by the colorants 8. The energy of the absorbed light excites electrons in the colorants and creates an increase energy state that is not stable and is subsequently dissipated as fluorescent light F emitted in all directions from the colorants. The ability of the human eye to perceive the emitted fluorescent light F is dependant on the intensity of the incident light.

As shown from the upper left side of Figure 1, the incident light I enters the first layer 6 and strikes colorant 8. When the light intensity is low some portion of colorants 8 absorbs energy from the light and achieves an increased energy state. The increased energy state is not stable and particles ultimately release the energy as emission of low intensity fluorescent light in all directions. The incident light also passes into a second layer 10 and is absorbed by the light absorbing particles 12.

Due to the presence of the light absorbing particles 12, the light absorbing layer 10 has an inherit color at all intensities of incident light I. The light absorbing layer 10 is either black or a dark color such as deep blue, deep green, deep purple, deep red or the like as evidenced by the color value R* of being less than 40. At low intensity light, the color produced by the absorbance of the colorants of 8 and 12 predominates, whereas at high intensity light, the fluorescence of the colorants 8 predominates. This results in the coating having different colors depending on the intensity of the incident light. In shade the coating will have one color and in sunlight another color. In order for this phenomena to occur it is critical that the colorants 8 be of a small size so that they will not scatter light that mask the light produced by absorbance and the light produced by fluorescence.

Dealing now with Babler reference, the reference relates to a coating and to a method of creating color in a coating which is very different than that claimed by Applicant. Babler comprises a pigment and a specific porous filler that gives a color coating with a three dimensional effect. The coating can be in a multi-layer configuration in which the color coating described immediately above can be over coated with a clear coating that may optionally contain fluorescent dyes. Applicant's claims differ from Babler in a number of areas. First of all there is no disclosure in Babler of a lower layer comprising a resinous binder and light absorbing particles which have a color value R* less than 40. Although Babler discloses a significant number of pigments, some of which may have a color value less than 40, it is certainly probable that many also have a color value L* greater than 40. Therefore there is no teaching or suggestion in Babler of using colorants having a color value less than 40. In addition, there is no disclosure in Babler of an upper layer containing dyes and pigments which are present in amounts of 0.001 to 50% by weight. Babler is silent as to the concentration of fluorescent dyes in his upper layer and there certainly would be no teaching of the specific concentration range required by Applicant's claims.

Finally, there is no disclosure in Babler of the method of creating color effect such as in Claim 12 of the present invention so as to give a first and second color appearance depending on the intensity of the incident light.

The Examiner has given no weight to the above mentioned differences, taking the position that such property limitations are inherently met by the coatings disclosed by Babler. It is believed the Examiner is mistaken. Federal Circuit decisions emphasize that an anticipatory inherent feature or result must be consistent, necessary, and inevitable, not merely possible or probable. See for example, Transclean Corp. v. Bridgewood Services, Inc., 290 F.3d 1364, 1373, 62 USPQ2d 1865 (Fed. Cir. 2002) ("anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must *necessarily* include the unstated limitation ... ."); Mel/Biophile International Corp. v. Milgraum, 192 F.3d 1362, 1365, 52 USPQ2d 1303 (Fed. Cir. 1999) ("Occasional results are not inherent."); *In re* Robertson, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999) (the PTO Board erred in holding that a prior art reference anticipated by inherency an applicant's claim, which concerned a diaper fastening and disposal system; the Board's analysis rested on mere probability or possibility, i.e., that elements in the reference could be used other than as disclosed and for a different function ("odd use"); such probability or possibility is not sufficient to establish inherency); W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303 (Fed. Cir. 1983), *appeal after remand*, 842 F.2d 1275, 6 USPQ2d 1277 (Fed. Cir. 1988) ("Anticipation of inventions set forth in product claims cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in references.").

For the above reasons, it is submitted that Applicant's claims are not anticipated under 35 U.S.C. 102 and reconsideration and withdraw of the rejection is respectfully requested. Should the Examiner have any questions

concerning this response, she is urged to contact Applicants attorney undersigned below.

Respectfully submitted,

William J. Uhl
Registration No. 25,567

Phone: (412) 496-3430
Fax: (412) 434-4292